



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/734,870

12/12/2003

William F. Leek

SIMP-51002US0

1550

28554 7590 01/13/2010
Vierra Magen Marcus & DeNiro LLP
575 Market Street, Suite 2500
San Francisco, CA 94105

EXAMINER

CHAPMAN, JEANETTE E

ART UNIT

PAPER NUMBER

3633

MAIL DATE

DELIVERY MODE

01/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|------------------------------------|--|
| Office Action Summary | Application No. 10/734,870 | Applicant(s) LEEK ET AL. | |
| | Examiner Jeanette E. Chapman | Art Unit 3633 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 14, 15, 17, 18, 25 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 14, 15, 17, 18, 25 and 38-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/2, 11/6 & 12/18/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 14-15 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gandara (5628495)

claim 11.

Gandara discloses a shearwall, comprising:

a central diaphragm 16/18, including:

a top edge and a bottom edge adjacent 32/22 generally defining a height of said central diaphragm,

first and second ends adjacent 12/14, extending between the top and bottom edges, generally defining a width of said central diaphragm, and

a corrugated section 28/20 extending partially between said top edge and said bottom edge in

between said first and second ends, said corrugated section 28/20 forming at least one

corrugation, said at least one corrugation extending from said bottom edge and terminating at a position between said bottom edge and said top edge.

12.- 13. (cancelled)

claim 14.

Gandara discloses a shearwall for a wall of a building, comprising:

a central diaphragm 16/18, including

Art Unit: 3633

a top edge and a bottom edge adjacent 32/30 or 26/22 generally defining a height of said central diaphragm 16/18, first and second ends adjacent 12/14, extending between the top and bottom edges, generally defining a width of said central diaphragm 16/18, said height being at least twice as long as said width.

a corrugated section 28/20 extending at least partially between said top edge and said bottom edge in between said first and second ends, said corrugated section 28/20 forming at least one corrugation; and

at least one embossment.

claim 15.

Gandara discloses a shearwall for location within a wall of a building, comprising:

a central diaphragm 80, including

a top edge and a bottom edge 88/90 generally defining a height of said central diaphragm 80, first and second ends 82/84, extending between the top and bottom edges 88/90, generally defining a width of said central diaphragm 80,

a corrugated section 86 extending at least partially between said top edge and said bottom edge 88/90 in between said first and second ends 82/84, said corrugated section forming at least one corrugation; and

at least one stiffening lip 32/30/26/22.

claim 25.

Gandara discloses a shearwall for a wall of a building comprising:

a central diaphragm 14/16 having a top edge 28/26 and a bottom edge 30/22 defining a height of said central diaphragm 14/16, first and second end sections 12/14 defining a width of the central

Art Unit: 3633

diaphragm, and a front

plane and a rear plane defining a depth of said central diaphragm, see figure 3, said central diaphragm including:

a pair of rear planar sections A extending at least part way between said top and bottom edges and being adjacent, respectively, to said first and second end sections, see figure 2 said pair of rear planar sections having a surface residing generally in said rear plane, a pair of angled sections B extending at least part way between said top and bottom edges and being adjacent, respectively, to said pair of rear planar sections, said pair of angled sections extending from said rear plane toward said front plane and angling toward each other, a front planar section C extending at least part way between said top and bottom edges and being adjacent said pair of angled sections, said front planar section having a surface residing generally in said front plane; and first and second chords affixed one each to said first and second end sections.

26. - 37 (canceled)

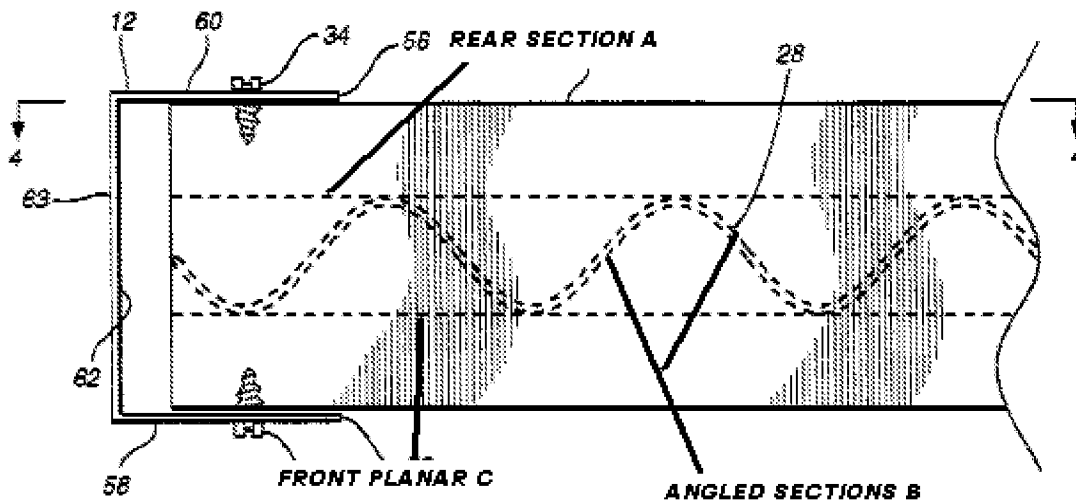
claim 42.

Gandara discloses a shearwall comprising: a first member 12 extending in the length direction between a top and bottom of the shearwall; a second member 14 extending in the length direction between the top and bottom of the shearwall;

a central diaphragm 28/20 welded to the first and second members, the central diaphragm having a top edge 88 and a bottom edge 90 defining a height of said central diaphragm, first and second end sections 82/84 defining a width of the central diaphragm, and a front plane C and a rear plane A defining a depth of said central diaphragm, said central diaphragm including: a pair

Art Unit: 3633

of rear planar sections extending at least part way between said top and bottom edges 88 and 90 and being adjacent, respectively, to said first and second end sections 82 and 84, said pair of rear planar sections A having a surface residing generally in said rear plane A, a pair of angled sections B extending at least part way between said top and bottom edges 88 and 90 and being adjacent, respectively, to said pair of rear planar sections A, said pair of angled sections B extending from said rear plane A toward said front plane C and angling toward each other, a front planar section C extending at least part way between said top and bottom edges 88 and 90 and being adjacent said pair of angled sections B, said front planar section C having a surface residing generally in said front plane.

FIG. 3

Claims 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Krottsch (4736566) claim 38.

krottsch discloses a shearwall for use in a building comprising:

a central diaphragm 12 having a top edge adjacent 16 and a bottom edge adjacent 18 defining a

Art Unit: 3633

height of said central diaphragm 12, first and second end sections adjacent 20 defining a width of the central diaphragm, the height being at least twice as long as the width, and a front plane and a rear plane A and B respectively defining a depth of said central diaphragm, said central diaphragm including:

a pair of rear planar sections A extending at least part way between said top and bottom edges and being adjacent, respectively, to said first and second end sections, said pair of rear planar sections having a surface residing generally in said rear plane,

a pair of angled sections C extending at least part way between said top and bottom edges and being adjacent, respectively, to said pair of rear planar sections, said pair of angled sections extending from said rear plane A toward said front plane B and angling toward each other,

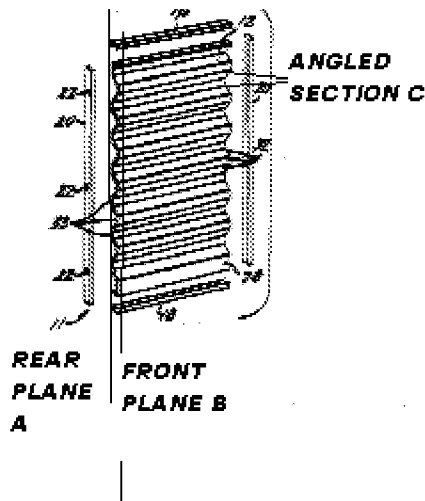
a front planar section B extending at least part way between said top and bottom edges and being adjacent said pair of angled sections, said front planar section having a surface residing generally in said front plane;

first and second side structural members adjacent 20 formed one each on said first and second end sections; and

first and second edge structural members adjacent 16/18 formed one each on said top edge and a bottom

Art Unit: 3633

edge.



claim 39.

Krotsch a shearwall as recited in claim 38, wherein the first and second structural members are chords.

Claim 40.

Krotsch discloses a shearwall as recited in claim 38, wherein the one of the first or second edge structural members sits within a channel. See figures 1,2 and 13

claim 41.Krotsch lacks the shearwall as recited in claim 40, wherein the channel is mounted to a sill plate as shown by Flachbarth et al. See sill plate 4. It would have been obvious to one of ordinary skill in the art to modify Krotsch to include the sill plate to provide a convenient mounting means for the panel within a building

Art Unit: 3633

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over claim 17.

Gandara discloses a shearwall, comprising

a central diaphragm 80/16/18 having a height, width and depth, each being perpendicular to each other, see figures 1 and 7 and a corrugation extending in the direction of said height of said central diaphragm; see figures 1 and 7

first and second (not wooden) chords 32/30/26/22 affixed to said central diaphragm at opposed edges of said central diaphragm and extending in the direction of said height of said central diaphragm;

a sill plate 22 affixed to a bottom of the shearwall, said sill plate having a footprint at least as large as said central diaphragm and said first and second chords together; and a channel, shown in figure 2, in which said central diaphragm resides.

The choice of materials has been considered a matter of choice; this choice lacks criticality and relevancy. One of ordinary skill in the art would have appreciated the most suitable material for the use of the shear wall. Wood and metal materials are well known in the art.

Claim 18.

Figure 2 of Gandara discloses a shearwall as recited in claim 17, said sill plate having a width

greater than that of said channel.

Applicant's arguments are moot in view of the new ground of rejection

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached at 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JEANETTE CHAPMAN/
PRIMARY EXAMINER
ART UNIT 3633